

REMARKS

In view of the following remarks responsive to the Non-Final Office Action dated April 20, 2005, Applicant respectfully requests favorable reconsideration of this application.

The Office has rejected claims 1, 2, 5, and 27–33 as anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,819,710 to Dupuis. The Office has allowed claims 9–26, and objected to claims 4, 6–8, 34 and 35 as depending from rejected claims. The Applicant thanks the Office for this indication of allowability.

Since all pending rejections rely on Dupuis as prior art, all rejections would be overcome by establishing that Dupuis is not prior art to the present invention. As discussed below, Dupuis is not prior art to the present application.

Dupuis has been cited as a prior art reference under 35 U.S.C. §102(e), namely, a United States patent application having a filing date earlier than the invention date of the claimed invention. Dupuis was filed on June 26, 2000. Although Dupuis is a continuation-in-part of application no. 09/480,058 (“the Parent Reference”), which itself claimed the benefit of provisional application no. 60/145,475 (“the Grandparent Reference”), Dupuis’s effective prior art date is its filing date, June 26, 2000. “In order to carry back the 35 U.S.C. 102(e) critical date of a U.S. patent reference to the filing date of a parent application, the U.S. patent reference must have a right of priority to the earlier date under 35 U.S.C. 120, or 365(c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph.” MPEP 2136.03 (quoting *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981)).

The effective prior art date of Dupuis is its filing date (June 26, 2000), rather than the filing date of the Parent or Grandparent References, because neither the Parent nor the Grandparent References support the invention claimed in claims 1–53 of Dupuis:

- Claim 1 of Dupuis recites the step of “communicating digital information between the line-side line-isolation integrated circuit and the system-side line-isolation circuit through the isolation barrier, *the digital information comprising the multiple bit digital value*” and “processing the digital data *[including the multiple bit digital value]* . . . with a digital processor *within the system-side line-isolation integrated circuit.*”
- Claims 16 and 35 of Dupuis require the use of at least one “programmable data register within the system-side line-isolation integrated circuit” for storing “event determination data.”
- Claim 27 of Dupuis requires determining “*within the line-side isolation integrated circuit* whether an intrusion event has occurred using the digital value representative of the indicator level.”
- Claim 46 of Dupuis requires “circuitry *within the line-side line-isolation integrated circuit* coupled to receive the multiple-bit digital value and configured to generate an intrusion event signal when an intrusion event has been determined to have occurred.”

None of the above limitations in the claims of Dupuis are supported by any description in either the Parent or Grandparent References, much less by an enabling written description that complies with 35 U.S.C. 112, first paragraph. Moreover, neither the Parent nor the Grandparent References disclose anything similar to Figure 4 of Dupuis, which the Office relied upon in rejecting claims 1, 2 and 5. Thus, the earliest effective filing date of Dupuis is June 26, 2000.

Applicants had conceived of and reduced to practice the invention claimed in each of rejected claims 1-15 prior to that date. Attached hereto is a Declaration of all of the inventors attesting to such facts. Because Dupuis is not prior art to any claim of the present application, all claim rejections are rendered moot.

In view of the foregoing remarks, Applicant asserts that the pending claims are in condition for allowance and respectfully request that the Office issue a Notice of Allowance at the earliest possible date. The Office is invited to contact Applicant's undersigned counsel by telephone call in order to further the prosecution of this case in any way.

Respectfully submitted,

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Dated

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